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**REMARKS**

In the Office Action mailed November 7, 2002, the Office has made final the following rejections: claim 12 is rejected under 35 U.S.C. §102(e), as being unpatentable over Shurling et al.; and claims 3-6, 9-11, and 16-23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Shurling et al. in view of Ferguson et al.

In view of the distinguishing remarks herein, the undersigned representative hereby respectfully requests reconsideration of claims 3-6, 9-12, and 16-23 earnestly solicits a Notice of Allowance.

**Rejection of Claim 12 Under 35 U.S.C. §102(e) as Being Unpatentable Over Shurling et al.**

Claim 12 includes the following limitations:

A method for leveraging a financial relationship between a customer and a financial institution, comprising:

establishing a financial account at the financial institution for the benefit of the customer;

adding value to the financial account at predetermined intervals, wherein the value is comprised of immediate access value and vested access value, and further wherein the immediate access value is added to the first financial account by the customer in an amount determined by the customer and at the direction of the customer;

calculating the vested access value by

(a) determining a number of individual components comprising the financial relationship,

(b) calculating an individual value for each of the individual components at the end of a set period of time,

(c) multiplying the determined individual value of each of the individual components by a pre-selected percentage to obtain a vested access value; and

adding the vested access value to the financial account, wherein the immediate access value is retrievable by the customer from the financial account without restriction, but the vested access value is only retrievable by the customer after a predetermined period of time.

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It is important to bear in mind that claim 12 requires that two different types of value, (1) immediate access value and (2) vested access value be added to the same financial account. Pursuant to the Final Office action, Pages 2-3, the Office has identified the financial account to be a "checking account" citing to Column 1, line 18 of Shurling et al. The Office further argues that, "e.g. payroll deposits," to the checking account are immediate access value added by the customer. Assuming, *arguendo*, that the checking account from Shurling et al. and the payroll deposits to the checking account meet the following limitations of claim 12:

... establishing a financial account at the financial institution for the benefit of the customer;  
adding value to the financial account at predetermined intervals, wherein the value is comprised of immediate access value and ~~vested access value~~, and further wherein the immediate access value is added to the first financial account by the customer in an amount determined by the customer and at the direction of the customer...

the Office still must show where Shurling et al. teach or suggest adding to the same checking account, "vested access value" according to the following limitations of claim 12:

calculating the vested access value by  
(a) determining a number of individual components comprising the financial relationship,  
(b) calculating an individual value for each of the individual components at the end of a set period of time,  
(c) multiplying the determined individual value of each of the individual components by a pre-selected percentage to obtain a vested access value

wherein,

the vested access value is only retrievable by the customer after a predetermined period of time.

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In order to show this teaching, the Office argues that "reduced banking fees" cited in Column 1, lines 26-27 are vested value according to Column 11, line 46 through Column 12, line 35 and Column 15, lines 9-24 which are set forth below:

An example of a typical scale file of the SPF 104, which is used to establish the relationship between the Relationship score and the degree or vesting of the Incentive Reward awarded, is illustrated in Table C below.

TABLE C

Above Percent	
10	15
25	30
40	75
60	100

In the example of Table C, the number of points in the customer's Relationship score is compared to the point values in the column marked "Above." The row in Table C is identified in which contains the greatest number in the "Above" column that is exceeded by the customer's Relationship score. The customer is awarded that percentage of the Incentive Reward indicated in the column marked "Percent" that is present in this same row. By using the vesting or scoring concept represented by Table C, Incentive Rewards such as a percentage point increase in a deposit account or a percentage point decrease in a loan rate may be partially awarded. Of course, other types of Incentive Rewards may not admit to being divided, and in which case the vesting or scoring concept would simply be a selected limit of points which the Relationship score would have to exceed to entitle the customer to receive the non-divisible Incentive Reward.

The procedures executed during the manual updating state 106 and the parameter establishing state 102 of the Relationship scoring and Incentive Reward awarding process 20 shown in FIG. 4 are generally illustrated by the procedures chart illustrated in FIG. 5. As shown in FIG. 5, a conventional program control procedure 120 and a conventional edit main menu procedure 122 establish an environment in the computer 22 (FIG. 1) in which the Relationship scoring and Incentive Reward awarding process 20 (FIG. 4) operates. The parameter establishing state 102 involves the execution of a conventional data table building procedure comprising a parameter maintenance handling procedure 124 which receives the parameter information and a SPF updating procedure 126 which updates the SPF 104 (FIG. 4) in response to the parameter maintenance handling procedure 124. The parameter establishing state 102 also includes a conventional screen data editing procedure 128 to create and revise information displayed on a visual display screen.

One procedure executed in the manual updating state 102 is a score transaction handling procedure 130 which receives information and identifies the type of transaction to be performed. The possible transactions include a query about the score or vesting of a particular customer or group of customers, adding a customer record to the customer database file, changing information in a record of the customer database file, and deleting a customer's record from the customer database. (Column 11, line 46 through Column 12, line 35)

The customer's Relationship score is then evaluated to determine 194 customer vesting. FIG. 8 illustrates details of the customer vesting determining step 194 of the manual updating state 106 (FIG. 6B). The scale file (Table C) 196 of the SPF 104 (FIG. 4) is retrieved and scanned 266

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starting with the bottom row of the scale file (Table C). The value in the "above" column (Table C) retrieved from a row is compared 268 in the "above" column is compared to the customer's Relationship score. If the value on the "above" column is less than or equal to 220 the Relationship score for the customer the vesting for the customer is set 272 at the value retrieved from the "percent" column that is in the same row of the scale file (Table C) 196 as the value from the "above" column that was less than or equal to the Relationship score. The vesting percentage is then stored 274 in the customer database file 172 of the RBF 108 (FIG. 4). (Column 15, lines 9-26).

The undersigned representative agrees that Shurling et al. teach a system and method for calculating an incentive award based a customer's relationship with a financial institution. But, the above-identified passages do not teach or suggest the limitations of claim 12 directed to the "vested access value." Summarizing the "vested access value" limitations, in order to sustain an anticipation rejection under 35 USC § 102, Shurling et al. must teach or suggest:

- calculating the vested access value by
  - determining a number of individual components comprising the financial relationship
  - calculating an individual value for each of the individual components at the end of a set period of time
  - multiplying the determined individual value of each of the individual components by a pre-selected percentage to obtain a vested access value
- adding the vested access value to the financial account
- wherein, the vested access value is only retrievable by the customer after a predetermined period of time

At most, Shurling et al. calculate and apply an increased interest rate on a deposit account or a reduced interest rate on a loan account or reduce banking fees based on a customer's relationship with the financial institution. Given the claim language and the description in the specification, an interest rate or reduced banking fee is not equivalent to "vested access value." Referring to The New Merriam-Webster Dictionary (1989), "vested" is defined as "fully and unconditionally guaranteed as a legal right, benefit or privilege." Similarly, "value" is defined as "a fair return or equivalent in money, goods, or services for something exchanged." Based on these definitions, claim 12 calculates a guaranteed amount of money

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based on the customer's financial relationship(s), adds this guaranteed amount of money to the customer's account and controls access by the customer to the guaranteed amount of money based on time. Calculating and changing the applicable interest rate on an account does not equate to calculating a guaranteed amount of money and adding the guaranteed amount of money to the financial account. Further, it clearly does not make sense that an interest rate would be "retrievable by the customer after a predetermined period of time." Contrary to the Office's arguments on Page 10, the claims in and of themselves necessarily dictate that the "vested access value" is money, i.e., funds, the amount of which is determined by a funding engine commensurate with the specification. This construction of the claim language is clear from the specification. Pages 3-8, including Table 1, of the specification, disclose that the vested value added to the customer's program account is a monetary amount. Claim 12 would be nonsensical if interpreted such that the phrase vested access value were replaced with "interest rate" or "reduced banking fee" as suggested by the Office. Shurling et al. do not teach or suggest each and every limitation of the claims as is required by statute. The undersigned representative kindly requests removal of this rejection and allowance of claim 12. As claims 16-22 include all of the limitations of claim 12, these claims are also allowable over Shurling et al.

**Rejection of Claims 3-6, 9-11, and 16-23 Under 35 U.S.C. §103(a) as Being Unpatentable Over Shurling et al. in View of Ferguson et al.**

Independent claim 3 includes the following limitations:

A method for leveraging financial relationships between a customer of a financial institution, the financial institution, and at least one third party, comprising:

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collecting financial relationship information separately from each of the customer, the financial institution, and the at least one third party;  
evaluating the financial relationships between the customer and the financial institution and the customer and the at least one third party based on the financial relationship information;  
awarding a total value to the customer based on the evaluation of the financial relationships;  
holding the total value award in a first financial account located at the financial institution for a predetermined period of time;  
selecting a second financial account located at the financial institution into which the total value award is transferred upon expiration of the predetermined period of time; and  
redeeming the total value award into the second financial account upon expiration of the predetermined period of time.

As stated by the Office, "Shurling does not specifically [sp?] inclusion of a third party and its relationships or the details of holding, transferring and redeeming a total value award."

Consequently, Shurling et al., do not meet the recitations of claim 3 as presented herein.

The Office cites Ferguson et al. as teaching those limitations not taught or suggested by Shurling et al. More particularly, that Ferguson et al. disclose relationships between a customer and a third party, i.e., a non-bank. The Office argues that between Shurling et al. and Ferguson et al., each of the limitations of claim 3 is taught. The undersigned disagrees. Recall that in order to establish a *prima facie* case of unpatentability, the Patent Office must show the following:

- (1) suggestion or motivation to modify the reference or to combine the reference teachings;
- (2) a reasonable expectation of success; and (3) **the prior art reference or references must teach or suggest all of the claim limitations**. See MPEP §2142. Shurling et al and Ferguson et al. in essence teach the same limitations, i.e., relationship information collection and evaluation by and between only 2 entities. No reference has been cited that teaches or suggests information collection from 3 separate entities, wherein the relationships between the entities are evaluated based on the information collected. Consequently, neither Shurling et al.

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nor Ferguson et al., either alone or in combination, disclose or suggest the combination of limitations recited in claim 3. Addressing the Office's statement on page 10 of the Final Office Action, the undersigned representative has not argued against the motivation to combine since the threshold prong, i.e., the prior art reference or references must teach or suggest all of the claim limitations, has not been met. Even assuming, *arguendo*, that the threshold prong had been met, the motivation provided by the Office makes sense for interactions between 2 entities, but not 3 entities. The Office argues that because the seller, i.e., bank or sponsor, wants to incentivize the customer to conduct business with the seller, this means that the same seller would obviously want to incentivize the customer to conduct business with a different seller. But, it is counterintuitive for a first seller to incentivize a customer to conduct business with a second seller. That is not how business works. Without more, this motivation fails. The undersigned representative respectfully submits that claim 3 and dependent claims 4-6 and 9-11 are allowable over the cited prior art.

Independent claims 23 includes the following limitations:

A method for funding at least one account of a customer at a financial institution comprising:

contributing immediate access value and future access value to the at least one account of the customer, wherein the immediate access value is contributed by the customer and is accessible by the customer at all time and the future access value is contributed by the financial institution and is accessible by the customer according to a vesting schedule; and

negotiating a value factor with at least one third-party, wherein the at least one third-party contributes value to the at least one account of the customer based on the negotiated value factor, and further wherein, the third-party value contribution constitutes future access value and is accessible by the customer according to a vesting schedule.

With regard to the Office's rejection of independent claim 23, the Office argues that "Shurling further suggests a negotiated value factor at Col. 11, line 46 to Col. 12, line 8; in this instance,

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increased activity results in more benefit to a participant." The section of Shurling cited by the Office is as follows:

An example of a typical scale file of the SPF 104, which is used to establish the relationship between the Relationship score and the degree or vesting of the Incentive Reward awarded, is illustrated in Table C below.

TABLE C

Above Percent	
10	15
25	30
40	75
60	100

In the example of Table C, the number of points in the customer's Relationship score is compared to the point values in the column marked "Above." The row in Table C is identified in which contains the greatest number in the "Above" column that is exceeded by the customer's Relationship score. The customer is awarded that percentage of the Incentive Reward indicated in the column marked "Percent" that is present in this same row. By using the vesting or scoring concept represented by Table C, Incentive Rewards such as a percentage point increase in a deposit account or a percentage point decrease in a loan rate may be partially awarded. Of course, other types of Incentive Rewards may not admit to being divided, and in which case the vesting or scoring concept would simply be a selected limit of points which the Relationship score would have to exceed to entitle the customer to receive the non-divisible Incentive Reward.

As is clear from this passage, Shurling et al. do not describe the step of negotiating a value factor with at least one third-party. Responding to the Office's assertion on page 11 of the final Office Action, there is nothing for the undersigned to argue against, since clearly, the reference neither explicitly nor implicitly teaches or suggests the negotiating step. Further, there is no requirement that the undersigned "claim a negotiation having any novel or unobvious elements" as suggested by the Office. And further still, the undersigned does not accept the Office's definition of "negotiation." Referring to The New Merriam-Webster Dictionary (1989), "negotiate" is defined as "to confer with another so as to arrive at the settlement of some matter." Clearly Shurling does not teach or suggest an embodiment wherein the customer confers with a third party or the bank confers with a third party to settle the matter of a value factor. This step is



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part of the combination method recited in claim 23. The burden is on the Office to present a *prima facie* case of unpatentability and has failed to do so since the references cited do not teach each and every limitation recited in the claim. Ferguson does not remedy this deficiency within Shurling. Also, for the reasons stated above with respect to claim 3, the interaction between three parties within the same method is not taught or suggested by the combination of Shurling and Ferguson. The undersigned representative respectfully submits that claim 23 is allowable over the cited prior art.

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CONCLUSION

The undersigned representative respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Office believes that the prosecution might be advanced by discussing the application with the undersigned representative, in person or over the telephone, we welcome the opportunity to do so.

Respectfully submitted,

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